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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/720,493	09/27/2001	Andrew James Williams	TECHN.017A	3394

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EXAMINER

JONES, DAMERON LEVEST

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 10/10/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/720,493

Applicant(s)

WILLIAMS ET AL.

Examiner

D. L. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 4/2/01; 9/27/02; 7/29/03; and 10/11/02.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-9, 11, 16 and 17 is/are allowed.
- 6) ☒ Claim(s) 12-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 & 15.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

ACKNOWLEDGMENTS

1. The Examiner acknowledges receipt of the following:
 - a. Paper No. 11, filed 9/27/02, wherein claim 17 was added and the specification and claims 1-16 were amended.
 - b. Paper No. 14, filed 7/29/03, wherein claim 10 was canceled.

Note: Claims 1-9 and 11-17 are pending.

APPLICANT'S INVENTION

2. Applicant's invention is directed to an antibody, use thereof, or a method of making the antibody wherein the specific binding member comprises an amino acid sequence having residues 99-106 of SEQ ID NO: 2 and residues 99-106 of SEQ ID NO: 1.

RESPONSE TO APPLICANT'S ELECTION

3. Applicant's election with traverse of Group I in Paper No. 14, filed 7/29/03, is acknowledged. The traversal is on the ground(s) that claims 13 and 16 should be rejoined into Group I. This is found persuasive. Hence, Group I now includes claims 13 and 16.

112 REJECTION

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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5. Claims 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 12, line 5: The claim as written is ambiguous because of the phrase 'under conditions to bring ...binding'. Specifically, it is unclear what conditions are claiming that are necessary to bring about the expression of the binding member. Hence, Applicant is respectfully requested to clarify the claim in order that one may readily ascertain what is being claimed.

Claim 13: Did Applicant intend to write a method claim? For example, 'A method of treatment/diagnosis of (condition) comprising administering an antibody comprising a specific binding member according to claim 1.'

Note: Applicant is reminded that the intended use of a compound/composition carries no patentable weight in a compound/composition claim, but should be properly be written as a method claim.

Claims 13: The claim as written is ambiguous because it is unclear what is being treated or diagnosed (e.g., tumors). Did Applicant inadvertently omit a portion of the sentence. Please clarify in order that one may readily ascertain what is being claimed.

Claims 14 (line 6) and 15 (line 6): Did Applicant intend to write 'SEQ ID NO:2' instead of 'SEQ ID NO:1'?

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SPECIFICATION

6. The disclosure is objected to because of the following informalities: on page 11, line 13, Applicant has written a website address. Specifically, PTO policy does not permit the PTO to link to any commercial sites since the PTO exercises no control over the organization, views, or accuracy of the information contained on these outside sites. Hence, Applicant is respectfully requested to delete the website address.

Appropriate correction is required.

ALLOWABLE CLAIMS

7. Claims 1-9, 11, 16, and 17 are allowable over the prior art of record.

COMMENTS/NOTES

8. The Examiner respectfully suggests that Applicant add a claim directed to the subject matter that was deleted in claim 10. Specifically, Applicant is requested to add new claim 18 which would be a duplicate of claim 10. The reasoning for such a suggestion is that the Examiner has searched the full scope of independent claim 1 in combination with a label selected from the group consisting of a detectable label and a functional label and found the additional limitations to neither be anticipated nor rendered obvious by the prior art of record.

9. It should be noted that no prior art has been cited against Applicant's claims; however, Applicant MUST address and overcome the 112 rejections above. Therefore,

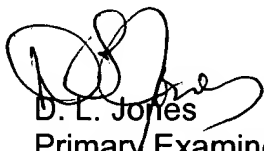
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the claims are distinguished over the prior art of record because the prior art neither anticipates nor renders obvious and antibody, use thereof, or a method of making the antibody wherein the specific binding member comprises and amino acid sequence having residues 99-106 of SEQ ID NO: 2 and residues 99-106 of SEQ ID NO. 1.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. The examiner can normally be reached on Mon.-Fri., 6:45 a.m. - 3:15 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308 - 2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.


D. L. Jones
Primary Examiner
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October 9, 2003